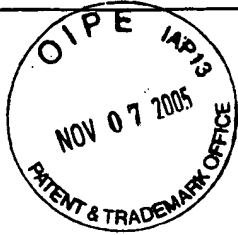


ARNOLD & PORTER LLP

202.942.5000  
202.942.5999 Fax

555 Twelfth Street, NW  
Washington, DC 20004-1206



November 7, 2005

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: U.S. Application No. 08/915,004  
Filed: August 20, 1997  
Title: Novel Proteins and Methods for Producing the Proteins  
Applicants: Masaaki GOTO *et al.*  
Atty. Docket: 16991.010

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office (PTO):

1. a Petition to the Commissioner; and
2. a return postcard.

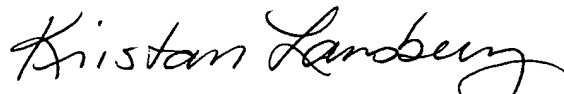
Please stamp the attached postcard with the filing date of these documents and return it to our courier.

Applicants request that the following fees be charged to Deposit Account No. 50-2387 referencing docket number 16991.010:

\$ 200.00 petition fee

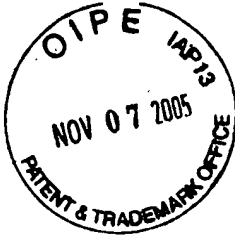
In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Applicants do not believe any fees, other than the petition fee (\$200.00), are due in conjunction with this filing. However, if any additional fees are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387 referencing matter number 16991.010. A duplicate copy of this letter is enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kristan L. Lansbery". The signature is fluid and cursive, with the first name "Kristan" and last name "Lansbery" clearly distinguishable.

David R. Marsh (Reg. Attorney No. 41,408)  
Kristan L. Lansbery (Reg. Agent No. 53,183)

Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

GOTO *et al.*

Appln. No.: 08/915,004

Filed: August 20, 1997

For: **NOVEL PROTEINS AND  
METHODS FOR PRODUCING  
THE PROTEINS**

Art Unit: 1636

Examiner: M. Pak

Atty. Docket: 16991.010

Confirmation No.: 9564

PETITION TO THE COMMISSIONER

**Mail Stop - Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the patent term extension ("PTE") indicated with the Notice of Allowance, mailed September 7, 2005, for the above-referenced application. Applicants herein apply for an extension of the patent term beyond what was calculated by the Patent Office due to U.S. Patent and Trademark Office ("USPTO") delay. The PTE suggested by the Determination of Patent Term Extension under 35 U.S.C. 154(b) mailed on September 7, 2005 is 1631 days. Applicants' calculations for the correct PTE follow.

The examination delay in this application begins on November 23, 1998, the date the first Notice of Suspension was mailed. Prosecution remained closed in this matter until the Notice of Allowance was issued almost seven years later. As such, Applicants respectfully request that the above-referenced application be given the maximum extension of five years or 1825 days.

11/09/2005 MBEYENE2 00000001 502387 08915004

01 FC:1455 200.00 DA

### Statement of Facts

1. The instant application was filed on August 20, 1997. As such, 37 C.F.R. §1.701 determines the amount of PTE. Under 37 C.F.R. §1.701(b), the term of a patent entitled to extension is calculated by the sum of delay under paragraphs (c)(1), (c)(2), (c)(3), and (d). The delay affecting patent term in the instant application falls under 37 C.F.R. §1.701(c)(1)(ii), the number of days in the period beginning on the date prosecution in the application was suspended by the USPTO due to interference proceedings and ending on the date of termination of the suspension.
2. November 23, 1998 was the date prosecution in the instant application was suspended by the USPTO due to interference proceedings. The Notice of Suspension, mailed on November 23, 1998, stated, "All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF SIX (6) MONTHS from the date of this letter." (emphasis in original). A copy of the Notice of Suspension is attached hereto as Exhibit A.
3. Following the suspension period, on June 8, 1999, July 16, 1999, August 4, 1999, Applicants submitted a status inquiry regarding the status of the instant application.
4. On August 31, 1999 another Notice of Suspension due to potential interference was mailed from the USPTO. Then, on March 8, 2000, April 10, 2000, May 10, 2000, Applicants submitted a status inquiry regarding the status of the instant application.
4. On June 8, 2000, another Notice of Suspension due to potential interference was mailed from the USPTO. Following this suspension period, Applicants submitted a status inquiry regarding the status of the instant application on December 11, 2000 and March 5, 2001.
3. On March 21, 2001, a communication from the USPTO was mailed, indicating that the above-identified application was to continue to be suspended due to a potential interference and/or the publication of prior art under 35 U.S.C. §102(e). The USPTO also requested certified translations of the priority documents. The Patent Application Information Retrieval (PAIR) access site suggests that this is the beginning of the examination delay resulting in PTE.

4. On April 9, 2001, Applicants responded to the March 21, 2001 communication by filing certified translations of the priority documents. Thereafter, inquiries concerning the continued suspension of action were submitted on July 31, 2002, October 7, 2002, December 20, 2002, March 5, 2003 and May 27, 2003.
5. On June 19, 2003, a Petition to the Commissioner was filed requesting status information. In response, Applicants received a Decision on Petition, mailed December 16, 2003, indicating that the application remained suspended due to a possible interference and was to be forwarded “[w]ithin a few days” to the Board of Patent Appeals and Interferences (BPAI) to determine whether an interference would be declared. Applicants note that in this Decision on Petition, the USPTO refers to suspension of prosecution on March 21, 2001 (the date alleged in PAIR as the beginning of the delay resulting in PTE).
6. A substitute specification was filed on February 17, 2004, and Applicants filed inquiries for status information on April 28, 2004 and July 1, 2004.
7. September 7, 2005 was the date of termination of the suspension when the Notice of Allowance was mailed.

## Conclusion

Applicants respectfully petition the Commissioner to review the PTE calculation and require a correction to the 5 year maximum or 1825 days.

The fee (37 C.F.R. §1.17(e)) may be \$200.00 for this petition. If so, the United States Patent and Trademark Office is hereby authorized to charge said fee, or a greater one if applicable, to our Deposit Account No. 50-2387. A duplicate copy of this petition is enclosed. However, Applicants request that any fee requirement be waived in that, according to MPEP Section 2720, Applicant is requesting review by way of a petition under 37 C.F.R. Section 1.181 and no fee is specified.

In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Applicants do not believe any fees are due in conjunction with this filing. However, if any fees are required in the present application, including any fees for extensions of time, authorization to charge such fees is given in the accompanying transmittal letter.

Respectfully submitted,



David R. Marsh (Reg. Atty. No. 41,408)  
Kristan L. Lansbery (Reg. Agent No. 53,183)

Date: November 7, 2005

ARNOLD & PORTER LLP  
555 Twelfth Street, N.W.  
Washington, D.C. 20004-1206  
(202) 942-5000 telephone  
(202) 942-5999 facsimile



# Exhibit A



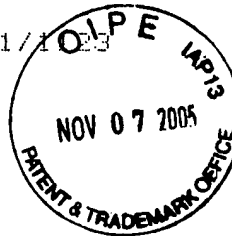
UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

DEAFCE-1994

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/915,004	08/20/97	GOTO	FJN-060(2999)

PATENT ADMINISTRATOR  
TESTA HURWITZ AND THIBEAULT  
HIGH STREET TOWER  
125 HIGH STREET  
BOSTON MA 02110

HM11/1023



EXAMINER	
SCHWARTZMAN, R	
ART UNIT	PAPER NUMBER
	13

DATE MAILED:

11/23/98

Please find below a communication from the EXAMINER in charge of this application

Commissioner of Patents

*Status Inquiry*  
*DOCKETED*  
*DUE: 5-23-99*

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is  
SUSPENDED FOR A PERIOD OF SIX (6) MONTHS from the date of this letter. Upon  
expiration of the period of suspension, applicant should make an inquiry as to the status of the  
application.

Any inquiry concerning this communication or earlier communications from the examiner  
should be directed to Robert Schwartzman whose telephone number is (703) 308-7307. The  
examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

Robert A. Schwartzman, Ph.D.  
November 16, 1998

NANCY DEGEN  
PRIMARY EXAMINER

RECEIVED  
TESTA, HURWITZ & THIBEAULT  
NOV 30 1998  
PATENT DOCKETING



# Interview Summary

Application No.

08/915,004

Applicant(s)

Goto et al.

Examiner

Robert Schwartzman

Group Art Unit

1636



All participants (applicant, applicant's representative, PTO personnel):

(1) Robert Schwartzman

(3) \_\_\_\_\_

(2) Christine C. Vito

(4) \_\_\_\_\_

Date of Interview Oct 29, 1998Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).Exhibit shown or demonstration conducted: ☐ Yes ☒ No. If yes, brief description:Agreement ☐ was reached. ☒ was not reached.Claim(s) discussed: None

Identification of prior art discussed:

None

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Examiner indicated that the papers filed October 16, 1998 had been received and that the after final amendment would be entered. The allowability of the claims is being considered.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☒ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

Examiner Note: You must sign and stamp this form unless it is an attachment to a signed Office action.